REMARKS

In an Office Action dated May 9, 2003, all of the pending claims (Claims 1-7) were rejected under 35 U.S.C. §102(e) over U.S. Patent No. 6,311,462 to Amborn et al. ("the '462 patent"). The '462 patent claims priority to U.S. Provisional Application No. 60/077,363 filed on March 9, 1998.

The present application claims priority to U.S. Application No. 09/876,822 filed June 7, 2001; U.S. Application No. 09/658,966 filed September 11, 2000; PCT Application No. US99/05103, filed March 9, 1999; and ultimately to U.S. Provisional Application No. 60/077,363, filed March 9, 1998. Accordingly, the present application claims priority from the same application, and therefore has the same priority date, as the '462 patent (i.e., March 9, 1998). Because the present application has the same priority date as the '462 patent, the '462 patent should not be applied as prior art against the present application. The rejection under 35 U.S.C. §102(e) has therefore been overcome.

Applicant further requests declaration of an interference under 37 C.F.R. §1.607 with U.S. Patent No. 6,311,462. *See* 37 C.F.R. §1.607(a)(1). The '462 patent is identical to the present application except that it names only Jerry Amborn and Vern Tiger as the inventors while the present application names John T. Aylward and C. Frederick DeMey as the inventors. The Applicants contend that Aylward and DeMey are inventors of this subject matter.

The subject matter defined in Claims 1-7 of the present application is identical in all respects to the subject matter defined by Claims 1-7 of the '462 patent. Accordingly, Applicant proposes that the present interference may be declared on the basis of a count corresponding to Claim 1 of the present application and the '462 patent, with Claims 2-7 denominated as corresponding to the count. *See* 37 C.F.R. §1.607(a)(2).

Subsequent to the above-requested amendments, Claim 1 of the '462 patent identically corresponds to Claim 1 of the present application meeting the requirements of 37 C.F.R. §§1.607(a)(3) and (4). *See* 37 C.F.R. §1.607(a)(3).

As filed, Claim 1 of the present application (prior to the above-requested amendments) corresponded exactly with Claim 1 as filed in the application (serial no.

09/847,675) of the '462 patent. The above-requested amendments are identical to amendments made to Claim 1 during prosecution of the '462 patent prior to issuance. Namely, in both the present application and the application of the '462 patent, an inadvertent repetition of "in a downstream direction" and two whereby clauses were deleted from Claim 1. The deletion of repetition of "in a downstream direction" merely corrected a clerical error and did not change the material limitations of the claim. In addition, the deletion of the whereby clauses resulted in no new matter so support does not need to be identified in the disclosure, thereby meeting the requirements of 37 C.F.R. §1.607(a)(5).

Further, the two whereby clauses merely state the result of the preceding recited elements and are therefore not considered to be limitations. *See Texas Instruments Inc. v. U.S. Int'l Trade Comm'n*, 988 F.2d 1165 (Fed. Cir. 1993) ("A 'whereby' clause that merely states the result of the limitations in the claim adds nothing to the patentability or substance of the claim."). With respect to the first deleted whereby clause in paragraph (c) of Claim 1 "whereby dosage forms will accumulate in said lanes when said dump gate is in said closed position," the whereby clause is merely a result of the dump gate "having a closed position wherein said dump gate blocks said lanes," as described earlier in the claim. Blocking the lanes will cause the dosage forms to accumulate because the dosage forms travel on the lanes.

With respect to the second deleted whereby clause in paragraph (d) of Claim 1 "whereby debris will be carried downstream out of said laning structure after said form handling device receives dosage forms from said laning structure," the whereby clause describes the result of opening the dump gate and allowing the dosage forms and debris associated therewith to continue along the laning structure. Because the two whereby clauses added nothing to the substance of originally filed Claim 1, Claim 1 of the present application described substantially the same subject matter at filing as Claim 1 of the '462 patent. Therefore, the requirements 37 C.F.R. §1.607(a)(6) and 35 U.S.C. 135(b) have also been met.

The Applicant has therefore met all of the requirements of 37 C.F.R. §1.607, including 37 C.F.R. §§1.607(a)(1)-(6), and solicits declaration of an interference between the present application and U.S. Patent No. 6,311,462 to Amborn et al.

It is not believed that extensions of time or fees for net addition of claims are required, beyond those, which may otherwise be provided for in documents accompanying this paper. However, in the event that additional extensions of time are necessary to allow consideration of this paper, such extensions are hereby petitioned under 37 CFR § 1.136(a), and any fee required therefore (including fees for net addition of claims) is hereby authorized to be charged to Deposit Account No. 16-0605.

Respectfully submitted,

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Glenda R. Ransom

10/29/2003
Date

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